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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/593,112	06/13/2000	Theresa M Gosko	M-8811	7080

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EXAMINER

CHANG, SABRINA A

ART UNIT PAPER NUMBER

3625

DATE MAILED: 09/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/593,112

Applicant(s)

GOSKO, THERSEA M

Examiner

Sabrina Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --.

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 June 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Drawings

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed. Please see form 948 for proper revision of drawings. The objection to the drawings will not be held in abeyance.

Specification

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

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Claims 1, 2, 5-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Henson U.S. Patent No. 6,167,383.

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Henson discloses an Internet-based shopping system for a configurable product, computers. A centralized database (catalog) powers the configurator, shopping cart and checkout modules [Col 4, Line 64] that the shopper accesses from a web-based user interface. A shopper can use the interface to configure their computer. A validation of their selected options is conducted to determine whether they are possible. The first type of validation is passive, providing a message to the shopper that specific options should not be included in the same configuration. The second type of validation is active where selection of a first option that precludes selection of a second option, the second option is automatically disabled [Col 8, Line 64]. After configuring the product to their specifications, the shopper can acquire real-time pricing of the modified selection [Figure 3B, Element 72]. Delivery and payment options are also customizable. [Col 12, Line 41].

Furthermore the shopper is classified into a specific customer set [Col 3, Line 35]. The customer set (defining business rules) thereby customizes the view of relevant options, both for the computer as well as for delivery and payment, for the shopper [Col 11, Line 53]. This

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grouping of different customer sets inherently discloses that there are various types of customers, including potentially a third party acting on behalf of the customer.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Henson U.S. Patent No. 6,167,383 in view of Official notice of practices widely known in the art of business automation.

Henson discloses a method of shopping for configurable products online.

In reference to claim 3, Henson does not explicitly disclose a method where the manufacturer includes a third party acting on behalf of the manufacturer

It is well known in the art of business automation that there exist many website and business process design service companies that manage the automated catalog and ordering systems of manufacturing companies. It would have been obvious to have a third party, such as one of these service companies, to automate the catalog process in order to reduce costs for the manufacturer and allow them to focus on their core competencies.

In reference to claim 4, Henson does not explicitly disclose that the purchase can configure the products independent of a third party provided configuration tool.

It is well known in the art of business automation that there exist many website and business process design service companies that manage the automated catalog and ordering

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systems of manufacturing companies in order to reduce costs for the manufacturer and allow them to focus on their core competencies. It would have been obvious, to even in the situation where the manufacturer offers the shopper an operable third party configuration tool, that the shopper could configure their desired product without using the tool, in order to provide the shopper with more options and make the shopping experience more comfortable for them.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gupta et al. U.S. Patent No. 5,825,651 discloses a method of configuring products based upon availability and compatibility of features and options. Gupta et al. does not explicitly disclose integrated commerce and billing functionality.

Brown U.S. Patent No. 6,115, 641 discloses a method in which computer catalogs are automatically updated and synchronized across different entities. Brown does not explicitly disclose any product configuration capability nor does it explicitly disclose billing and payment functionality.

Maritzen et al. U.S. Patent No. 5,970,719 discloses a method of configuring a product and acquiring real-time updated quote information for the modified product. Maritzen does not explicitly disclose any commerce or billing functionality.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sabrina Chang whose telephone number is 703 305 4879. The examiner can normally be reached on 8:30 am - 5:30 pm Mon.- Fri..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703 308 1344. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305 7687 for regular communications and 703 305 7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308 1113.

SC
September 13, 2002


WYNN W. COGGINS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600